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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,475	05/15/2001	William Grey	101.036	9618
48175	7590	12/01/2004	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,475

Applicant(s)

GREY ET AL.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 46 and 48-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46 and 48-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant filed claims 1-47 on 16 May 2001.

In a First Office Action of 14 September 2004, The Examiner issued an Election/Restriction Requirement.

In a response of 14 October 2004, applicant cancelled claims 1-45 and 47, leaving only Group VII, i.e., claim 46, of the original set of claims.

Applicant also added claims 48-62,

Claims 46, 48-62 are pending and will be examined.

### *Priority*

It is noted that this application appears to claim subject matter as follows:

[0001] This patent application is related to co-pending patent application entitled Method and Apparatus for Establishing Multiple Transactions to Fulfill a Requirement Involving a Product, which has application Ser. No. \_\_\_\_\_ and was filed on May 15, 2001, and to co-pending patent application entitled Method and Apparatus for Conducting Multiple Transactions, which has application Ser. No. \_\_\_\_\_ and was filed on May 15, 2001, both of which are incorporated herein by reference.

A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

The Examiner requests the Applicant identify where in the prior applications the features of the present invention are first disclosed. Since the prior applications also list different inventors than the present application (but with at least one common inventor), the examiner also requests the Applicant identify which inventor(s) contributed which features claimed in the present application that were also present in one or more prior application with different inventors.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally

delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46, 48-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah et al. (US 5,710,887).

***As per claim 46***, Chelliah methods and systems for facilitating transactions, including:

Processor(s) (for example, Col. 4, line 60-Col. 5, line3) operative to perform at least the following functions.

Associate a plurality of rules with a respective plurality of entities. See, for example, at least references to business rules, Col. 1, lines 28-Col. 2, line 3), pricing rules (Col. 12, line 28-Col. 13, line 12).

Determine that one of said entities is conducting transaction(s). See, for example, at least Col. 6, lines 26-65.

Authorize the transactions according the rules. See, for example, at least Col. 14, lines 39-Col. 15, line 4.

**As per claim 46**, Chelliah **does not** use the words "memory" and "communication port."

It is well known that computer systems such as disclosed by Chelliah often include memory and communication ports. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Chelliah and knowledge generally available to include memory and communications ports.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Chelliah and knowledge generally available to include memory and communications ports for the obvious reason that computers often need devices where information can be stored and retrieved such as memory, and pathway(s) into and out of a computer for functions such as communications.

**As per claim 48**, Chelliah discloses that the rules may be based, at least in part, on at least one of the following:

a barter credit; a spot price for a product; a price of a product involved in said transaction; a minimum number of products purchased during said transaction; a maximum number of products purchased during said transaction; a payment term associated with said transaction; a delivery requirement associated with said transaction; a shipping requirement associated with said transaction; a quality

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requirement for a product involved in said transaction; bundled products associated with said transaction; a customer associated with said transaction; an amount of inventory of a product involved in said transaction; and availability of a product involved in said transaction.

Please see at least references to quantity discounts, Col. 7, lines 17-30.

**As per claim 49**, Chelliah discloses determining a rule from a plurality of rules includes one of the following:

determining an identifier associated with said one of said plurality of entities; and receiving a notification of said rule.

Please see at least references to sponsor identifier and price discounts, at least Col. 19, line 35-Col. 20, line 67.

**As per claim 50**, Chelliah discloses that determining that one of said plurality of entities is conducting a transaction includes receiving a notification that one of said plurality of entities is conducting a transaction. Please see at least references to transaction processing, at least Col. 12, line 28-Col. 13, line 10.

**As per claim 51**, Chelliah discloses that receiving a notification that one of said plurality of entities is conducting a transaction includes at least one of the following:

receiving said notification from a user device; receiving said notification from a server; receiving said notification from a device associated with a marketplace; receiving an electronic communication via a communications network; receiving a notification of a marketplace involved in said transaction; receiving said notification from said entity; receiving said notification from a marketplace involved in said transaction; and receiving said notification from a party other than said entity involved in said transaction.

Please see at least references to customers selecting to enter the electronic mall via a user interfaces, at least Col. 6, line 4-57.

**As per claim 52**, Chelliah discloses that notification comprises at least one of the following:

an email message; an XML feed; an HTTP transmission; an HTML transmission; an FTP transmission; a wireless transmission; an instant message communication; an electronic communication sent via a communications network; a facsimile transmission; a telephone signal; and a radio signal.

Please see at least references to communications over a network such as the Internet, at least Col. 1, line 13-Col. 2, line 35.

**As per claim 53**, Chelliah discloses that associating a plurality of rules with a respective plurality of entities includes at least one of the following:

determining at least one rule that will apply for an entity conducting a transaction; and receiving a notification of a rule to associate with one of said plurality of entities.

Please see at least references to sponsor identifier and price discounts, at least Col. 19, line 35-Col. 20, line 67.

**As per claim 54**, Chelliah discloses that provide a notification regarding said transaction to a marketplace. See, for example, setting up discount programs, etc., at least Col. 7, line 7-64.

**As per claim 55**, Chelliah discloses that provide a notification regarding said transaction to said one of said plurality of entities. See, for example, at least Col. 7, line 7-64.

**As per claim 56**, Chelliah discloses that rule includes a condition and a result. See, for example, at least references to Pricing Engine, which applies rules, conditions and calculates results, such as discounts, Col. 18, line 11-Col. 19, line 35.



**As per claim 57**, Chelliah discloses that condition includes at least one of the following:

a requirement that a minimum number of products be purchased as part of said transaction; a requirement of a predetermined lead time between said transaction and delivery of a product involved in said transaction; a requirement of a predetermined lead time between said transaction and shipping of a product involved in said transaction; a requirement of a cumulative transactional volume over a desired time period; a requirement of a cumulative transactional volume by said one of said plurality of entities, a requirement of a cumulative transactional volume at a desired marketplace; a requirement of an availability of a product involved in said transaction; a requirement that a specific entity be involved in said transaction; a requirement that a specific marketplace be involved in said transaction; a requirement that a specific marketplace not be involved in said transaction; a requirement that a specific entity not be involved in said transaction; a requirement for an insurance policy associated with said transaction; a requirement that a specific product be bundled with said transaction; a requirement of a minimum financial amount involved in said transaction; and a requirement of a desired security associated with said transaction.

See, for example, at least references to various types of incentives, price discounts that may take place based on requirements such as quantity, Col. 7, line 16-39.

**As per claim 58**, Chelliah discloses that transaction involves at least one of the following: a dynamically priced product and a non-financial product. See, for example, at least Col. 5, line 61-Col. 6, line 3, concerning stock shares.

**As per claim 59**, Chelliah discloses that determine a charge associated with at least one of

said associating a plurality of rules with a respective plurality of entities, said determining that one of said plurality of entities is conducting a transaction, said determining a rule from said plurality of rules that is associated with said one of said plurality of entities, and said authorizing said transaction.

See, for example, at least Col. 12, line 28-Col. 13, line 10 concerning determining that an entity is conducting a transaction.

**As per claim 60**, Chelliah discloses that provide a notification of said charge. See, for example, at least Fig. 15 and related text concerning notification process.

**As per claim 61**, Chelliah discloses that charge is based, at least in part, on at least one of the following:

a monetary amount involved in said transaction; a non-financial product involved in said transaction; a dynamically priced product involved in said transaction; an anticipated cost savings associated with said transaction; a realized cost savings associated with said transaction; a cost associated with said transaction relative to a benchmark; an anticipated benefit associated with said transaction; a realized benefit associated with said transaction; a benefit associated with said transaction relative to a benchmark; a delivery requirement associated with said transaction; a financial requirement associated with said transaction; a number of entities in said plurality of entities; a number of rules in said plurality of rules, a number of products involved in said transaction; a number of times said rule from said plurality of rules has been applied in previous transactions; a number of times said entity from said plurality of entities has been involved in previous transactions; and a marketplace involved in said transaction.

See, for example, at least references to Pricing and pricing engine, money totals and discounts, at least Col. 18, lines 26-Col. 19, line 35.

**As per claim 62**, Chelliah discloses that a rule from a plurality of rules may modified modify said rule from said plurality of rules. See, for example, at least Col. 1, lines 15-Col. 2, line 3.

### **Conclusion**

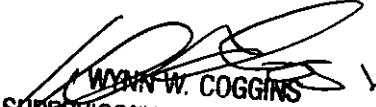
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jt  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
25 November 2004

  
**WILLIAM W. COGGINS**  
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